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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/679,334

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Tetsu Fukuda

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EXAMINER

SAWAGED, SARI S

ART UNIT

PAPER NUMBER

4126

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/679,334	FUKUDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sari Sawaged	4126	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/7/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/18/2004, 3/22/2005, 6/24/2005, 11/17/2005</u> .             | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the switching means and the first and second recording units must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The figures disclose a FIFO, streaming information storage unit, memory, and a hard disk, yet they fail to identify switching means and the first and second recording units.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 recites the limitation "the broadcast data" in Line 3. Claim 5 is dependent on claim 1. Claim 1 does not disclose "broadcast data". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**6. Claims 1, 2, 3, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah-Nazaroff et al. (hereinafter referred to as Nazaroff) (US 2002/0010930).**

7. Regarding claims 1 and 2, Nazaroff discloses an apparatus and method wherein there is a first data receiving means via a first medium and a second data receiving means via a second medium (see Figs. 5 & 6 and paragraph 0037) and a switching means for in response to an even message, switching reception and/or playback of the data received by the first data the first data receiving means and the data received by the second data receiving means (see paragraphs 0025 and 0030).

8. Regarding claim 3, Nazaroff discloses a first data receiving means receiving communication data via the internet from an external device (see figures 5 and 6 and paragraph 0043) and a second data receiving means receiving broadcast data sent from a broadcast station via a broadcast network (see figures 5 and 6 and paragraph 0037). Claiming that the receiving apparatus includes a decoder for decoding the communication data received is inherent. The decoding method would depend on the medium that is used. Nazaroff discloses a switching means between the decoding methods (sources) (see figure 4 and paragraphs 0030 and 0031).

9. Regarding claim 4, Nazaroff discloses a receiving apparatus with switching means between broadcast data and communication data (see figures 5 and 6 and

paragraphs 0030 and 0031). Switching the decoding method for the different sources is inherent to the system.

10. Regarding claim 6, Nazaroff discloses that in response to an event message indicating that a commercial message starts or indicating content such as news starts, the switching means switches data reception of data from an external device via the internet to a reception of data from a broadcast station via a broadcast network (see figures 4-6 and paragraphs 0024, 0025, 0030, and 0031).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nazaroff in view of Tsuchida et al. (hereinafter referred to as Tsuchida) (US 2002/0194593).**

13. Regarding claims 5 and 7, Nazaroff discloses two storage units (see figure 6) for storing data (data system memory and mass storage (see figure 6 and paragraph 0041 and 0044)). Nazaroff discloses that these storage units are used for temporary storage

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of data and programming instructions or for permanent storage of data and programming instructions. Nazaroff doesn't specifically associate the operation of the recording units with the switching unit. However, Tsuchida, an inventor from the same or a similar field, discloses a method/apparatus with recording capabilities where a user is able to view live broadcast and communication data (see paragraphs 0027, 0029, and 0032). When the viewer is watching broadcast data and a commercial break starts, the data is switched from broadcast data to communication data, automatically or at the viewer's discretion (see paragraphs 0027 and 0060). When the commercial break ends and the broadcast data continues, the user can opt to continue to view the communication data while the broadcast data is recorded to a recording unit so that when the viewer returns to view the broadcast data, the user can continue from where they left off (see paragraph 0076). Tsuchida also discloses storing URL addresses and tags of communication data in a recording unit so that when a commercial break is encountered again, the apparatus "receives the remaining communication of the program...based on the information on the communication data of the program recorded" in the storage unit (see paragraphs 0032 and 0075). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inventions of Nazaroff and Tsuchida because it would have allowed the consumer greater flexibility when viewing programming, without needing to worry that any live broadcast data or communication data will be missed when switching between the two sources.



**14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nazaroff in view of Tsuchida in further view of Eldering (US 2002/0083442).**

15. Regarding claim 8, neither Nazaroff nor Tsuchida disclose that the information on the communication data of the program includes data identification information of the program and a playback duration of the program. However, this is very well known to a person with ordinary skill in the art at the time the invention was made. Eldering (US 2002/0083442), an inventor from the same or a similar field, discloses that advertisements contain advertisement resource locators (ARLs) that indicate information such as the duration of an advertisement, identity of the advertiser, and the identity of the particular advertisement (see Eldering paragraphs 0039 and 0040).

It would have been obvious to combine the teachings of Nazaroff and Tsuchida with Eldering because, "this information can be useful for purposes of billing advertisers for display of their advertisements. ARLs can easily be applied to other programming data (see Eldering paragraphs 0039 and 0040).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sari Sawaged whose telephone number is (571) 270-5085. The examiner can normally be reached on Mon-Thurs, 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doon Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sari Sawaged/

Examiner, Art Unit 4126

/Dennis-Doon Chow/

Supervisory Patent Examiner, Art Unit 4126